



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/313,436	05/17/1999	DAVID S. SPRINGER	M-7260US	3911

7590

07/17/2006

DAVID L MCCOMBS  
HAYNES & BOONE LLP  
901 MAIN STREET  
SUITE 3100  
DALLAS, TX 75202-3789

EXAMINER
----------

LE, KHANH H

ART UNIT	PAPER NUMBER
----------	--------------

3622

DATE MAILED: 07/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.



33 UNITED STATES PATENT AND TRADEMARK OFFICE

---

Commissioner for Patents

United States Patent and Trademark Office

P.O. Box 1450

Alexandria, VA 22313-1450

[www.uspto.gov](http://www.uspto.gov)

**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/313,436

Filing Date: May 17, 1999

Appellant(s): SPRINGER, DAVID S. et al.

**MAILED**

JUL 17 2006

**GROUP 3600**

---

James R. Bell (Registration No. 26,528)

For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 04/27/2006 appealing from the Office action mailed 07/20/2005.

Art Unit: 3622

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct. (Claims 1, 4-6, 8-9, and 26-31 remain in the application. Claims 1 and 26 are independent).

**(4) Status of Amendments After Final**

No amendment after final has been filed.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

US 6,119,098	Guyot et al.	09-2000	
US 6,285,983	Jenkins	09-2001	
US 5,848, 397	Marsh et al.	12-1998	
US 6249795 B1	Douglis	06-2001	(prior art support for assertion of well-known fact)

Synonyms of "to imbed" from thesaurus.com (<http://thesaurus.reference.com/browse/imbed>)

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 103***

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. **Claims 1, 4-5, 8-9, 26-28, 30-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Guyot et al., US 6119098 herein Guyot in view of Jenkins, US 6285983, hereinafter Jenkins.**

As to claims 1, 8, 26, and 30, Guyot discloses

A method of tracking information provided to a computer system from an advertisement database and associated server, the method comprising:

providing an identifier unique to the computer system, (see at least col. 3 lines 18-22 : “ *each of the subscriber system 300 having a unique proprietary identifier*” , col. 3 lines 25-30, 55-65 ; Fig. 3 and associated text),

the database (“subscriber data” in the “database 220”) associating the identifier (the “subscriber identification information”) with information specific ( “personal profile”) to a computer user associated with the computer system (see at least Fig. 5 and associated text; col. 3 lines 18-22, 25-30, 55-65 )

the computer user establishing a web connection with the server and transmitting

Art Unit: 3622

the identifier to the database (see at least Fig. 5 and associated text; see item S500 of Fig 5: internet connection; transmitting the identifier to the database is inherent);

the user logging on to a combination advertisement broker server(see at least Fig. 5, see item S500, and associated text),

the computer system transmitting the identifier and requesting that a banner advertisement be displayed on the computer system (see at least col. 3 lines 25-30 )

the database checking for the identifier (inherent in the system; see at least col. 3 lines 55-65) ;

a counter accounting for the presence of the identifier (inherent in the system; a count of one is at least done; see at least col. 3 lines 55-65 : see explanation in bold below) ;

and

based on the number of times the database locates the identifier, the database:

determining which advertisements have been transmitted to the user (see at least Figs. 5, 8 and associated text; **Fig 6(B) step S590 ( counting ads seen) ; col. 8 lines 51-65, col. 6 line 64 to col. 7 line 11, col. 3 lines 64-col. 4 lines 16 discloses collection of data about the number of times an ad has already been distributed and already been displayed to a user (where each ad is designed to be shown a particular subscriber a maximum number of times only and within a time period only). This means the system, necessarily checks the identifier, associating it with the user, and counts the number of times the user identifier is located and associated with a particular ad in order to be able to count the number of times each ad is displayed to/seen by each subscriber); and**

based on the computer user associated with the identifier receiving a predetermined number of ads in a time period (see at least Figs. 5, 8 and associated text; col. 8 lines 51-65, col. 6

Art Unit: 3622

line 64 to col. 7 line 11 , col. 3 lines 64-col. 4 lines 16), the user associated with the identifier receiving credits

**(col. 6 lines 6-29 discloses“ [the system] assigns credits to the subscriber based on the number of advertisements the subscriber has been exposed to”; col. 2 lines 36-42 discloses monitoring user activity, i.e. including ads seen, over a predetermined period of time; col. 3 lines 64-col. 4 lines 16 discloses each ad is designed to be shown a particular subscriber a maximum number of times only and within a time period only; thus these combined disclosures suggest credits given to the user based on a predetermined number of ads received in a time period ).**

Guyot discloses ads presented to a user from some merchant source and consumer remuneration as credits for viewing the ads (see col. 6 lines 6-29).

However Guyot does not specifically disclose the server is accessed by a computer manufacturer or that the credits given for viewing ads are discounts on advertised computer components from the manufacturer. However it would have been obvious to one skilled in the art at the time the invention was made to apply GUYOT's method to computer manufacturers to allow this type of merchants to use GUYOT's method. Further, it would have been obvious to one skilled in the art at the time the invention was made to substitute to GUYOT's credits given, discounts on advertised computer components for the manufacturers, in case these latter are involved, to provide credits in a form that is relevant to products that would obviously be likely to be advertised by such merchants, computer components.

Further, Guyot does not specifically disclose the identifier is stored on a (the user's) hard drive (claims 8 and 30 ) or is imbedded in the user computer hardware (claim 1) However, in the analogous advertising art, Jenkins discloses that

*“As is known in the art, cookie files may be installed by a*

Art Unit: 3622

*web site server on the computer hard disk drive of a browsing consumer”* (see at least col. 1 lines 18-39).

It would have been obvious to one skilled in the art at the time the invention was made to install the cookie file on the user hard drive to implement the user identification method of Guyot because such cookie implementation technique is well-known (typical) as stated in Jenkins.

As to claims 4, 27 (dependent on claims 1 and 26 respectively), Guyot discloses the server hosting the advertisements and informational data (see at least the abstract, advertisements are also informational data).

As to claims 5 and 28 (dependent on claims 1 and 26 respectively), Guyot discloses the database searching and locating advertisements that match criteria provided by the computer user during a querying procedure (see at least col. 3 lines 55-65; Fig. 8 step S 601 and associated text)

As to claims 9 and 31 (dependent on claims 1 and 26 respectively), Guyot does not specifically disclose the information specific to the computer user includes one of incentives, bonuses and discounts on a plurality of goods, however it discloses targeted ads (abstract). Official Notice is taken that it is well-known and customary to advertisements often include promotional offers, such as product or service discounts and vouchers to promote consumption. It would have been obvious to one skilled in the art at the time the invention was made to add targeted discounts to Guyot's targeted ads for the above-stated advantage.

**7. Claims 6 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Guyot in view of Jenkins, and further in view of Marsh et al., US 5848397, herein Marsh.**

As to claims 6 and 29 (dependent on claims 5 and 28 respectively), Guyot does not specifically disclose that if no matching criteria is found, the database transmitting one of generic advertisements and no advertisements. However, in analogous arts, Marsh discloses that default (generic) ads or no ads are displayed when no other criteria for display are met (see at least col. 13 lines 40-53) as a display default method. It would have been obvious to one skilled in the art at the time the invention was made to add this display default method to Guyot for the above-stated advantage.

#### **(10) Response to Arguments**

From pages 6-9 of the Brief, Appellants just repeat parts of the Office Action. The first argument appears at page 9 that the reference (or references) fail to teach or suggest all claim elements.

Appellant seems, first, to argue that the limitation “the server is accessed by a computer manufacturer or that the credits given for viewing ads are discounts on advertised computer components from the manufacturer” is not disclosed.

The Examiner agrees Guyot does not specifically disclose that limitation.

However it is a well-known fact that computer manufacturers are a type of merchants. It is also a well-known fact that as such, these merchants sell computer components and are likely to desire to advertise them. Thus the Examiner had stated that “it would have been obvious to one skilled in the art at the time the invention was made to apply Guyot's method to computer manufacturers to allow this type of merchant to use Guyot's method.” Since Guyot discloses credits given, and discounts, it was stated “further it would have been obvious to one skilled in the art at the time the invention was made to substitute to Guyot's credits given, discounts on



Art Unit: 3622

advertised computer components for the manufacturers, in case these latter are involved, to provide credits in a form that is relevant to products that would obviously be likely to be advertised by such merchants, computer components."

Thus, contrary to argument, the combination of Guyot and the well-known facts as above-discussed, together with the motivation to combine these references as discussed above, satisfy the 35 U.S.C. 103(a) requirement as to the limitation in question.

At page 11, 2<sup>nd</sup> and 5<sup>th</sup> full paragraphs of the Brief, Appellants argue that the claimed invention provides "*a unique identifier imbedded in a system component by the manufacturer (emphasis added) associated with a database including information specific to the user of the system provided by the manufacturer (emphasis added) . This is uniquely unlike the Guyot system which provides advertisements to subscribers based on a personal profile provided by that subscriber. "*

However nothing in the claim requires a reading of imbedding the identifier "*by the manufacturer*", (especially not by the manufacturer mentioned in the preamble) nor that the database is "*provided by the manufacturer*" as argued.

At page 11, 4<sup>th</sup> full paragraph of the Brief, Appellants again argue "*The unique identifier of the present invention is imbedded in a system hardware or software component during manufacture (emphasis added), which is uniquely unlike the cookie file installed on a hard disk drive of a browsing consumer in Jenkins. "* However again nothing in the claim requires a reading of imbedding "*during manufacture*" as argued.

Claims 1 and 26 only claim "*providing an identifier unique to the computer system, the identifier being imbedded in one of the computer hardware or firmware "*.

Art Unit: 3622

As stated during prosecution, Guyot does not specifically disclose the identifier is stored on a (the user's) hard drive (claims 8 and 30 ) or is imbedded in the user computer hardware (claim 1). However, in the analogous advertising art, Jenkins discloses that "*As is known in the art, cookie files may be installed by a web site server on the computer hard disk drive of a browsing consumer. Cookies typically include information indicating that the browser has visited that website*" (see at least Jenkins, col. 1 lines 18-40; col. 4 lines 36-61) to monitor her online activities and uniquely identify the user . (The "information *indicating that the browser has visited that website*" mentioned by Jenkins is a unique identifier to identify the browsing user, as is well-known by Jenkins' application time. See e.g. Douglass US 6249795 B1, col.7 lines 48-52, herein provided as prior art support for this well known fact).

As stated during prosecution it would have been obvious to one skilled in the art at the time the invention was made to install the cookie file on the user hard drive to implement the user identification method of Guyot because such cookie implementation technique is well-known (typical) as stated in Jenkins ( col. 1 lines 37-40 ).

According to thesaurus.com , ( see [//thesaurus.reference.com/browse/imbed](http://thesaurus.reference.com/browse/imbed), synonyms of "to imbed" include "to attach", "to plant", "to place", "to install", "to lodge", "to set" etc.... Since a hard disk is hardware and since the user ID in a cookie is "stored" or "lodged" or "imbedded" on such hardware, the limitation "*providing an identifier unique to the computer system, the identifier being imbedded in one of the computer hardware or firmware*" is satisfied by storing a cookie on the user computer as taught by Jenkins.

The motivation to combine Guyot and Jenkins is provided as set forth above, does not use information glanced only from Appellants' disclosures and thus satisfy 35 USC 103(a) requirements.

"Any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning, but so long as it takes into account only knowledge which was within level

Art Unit: 3622

of ordinary skill at time claimed invention was made and does not include knowledge gleaned only from applicant's disclosure, reconstruction is proper.” *In re McLaughlin*, 170 USPQ 209 (CCPA 1971)

At page 11, 5<sup>th</sup> full paragraph of the Brief, Appellants further argue

“There is no supporting reference which teaches or suggests tracking information provided to a computer system from an advertisement database accessed by a computer manufacturer to provide discounts to users, based on a user receiving a predetermined number of advertisements that are tracked in a time period and associated with an identifier, as claimed. However Guyot/Jenkins discloses “tracking information provided to a user computer system from an advertisement database accessed by an advertiser/merchant to provide discounts to users, based on a user receiving a predetermined number of advertisements that are tracked in a time period and wherein the user is necessarily associated with an identifier (via at least a cookie file as taught by Jenkins) .

Computer manufacturers as stated above are just another type of advertising merchants (see page 5 above).

As stated above, it would have been obvious to one skilled in the art at the time the invention was made to add computer manufacturers as another user of the Guyot/Jenkins method to allow these particular advertising merchants to use the methods taught by Guyot/Jenkins in their advertising endeavors.

At page 12 of the Brief, Appellants further argue undesirability of the combination of Guyot and Jenkins, citing some well-known problems of cookies. The Examiner notes that the 3 defects of cookies argued, to wit, inability of cookies for automatic identification of the user to enable revenue sharing, automatic correlating of user preferences for targeted advertising, and lack of security, are first undocumented, and then address features that are not claimed, and therefore are irrelevant.

Further, for example, as to cookies used of automatic correlating of user preferences for targeted advertising, Jenkins clearly show used of cookies to derive preferences (profiles) for targeted offers.

Guyot teaches identifying users for monitoring of ads exposure, delivery of targeted ads and compensation based on viewing ads. Jenkins adds to Guyot the specific use of cookies for user identification in the same context of monitoring online behavior for better ads/offers targeting. Jenkins clearly suggests the need and the success for such user identification at (col. 4 lines 34-61) in the collection of consumer behavior data, by different sources, one of which is web browsing history, by using cookies files.

Thus as stated earlier, it would have been obvious to one skilled in the art at the time the invention was made to install the cookie file on the user hard drive to implement the user identification method of Guyot because such cookie implementation technique is well-known (typical) as stated in Jenkins ( col. 1 lines 37-40).

The motivation is adequate, the prima facie case is clearly made.

Lastly, it is noted “law of obviousness does not require that references be combined for reasons contemplated by inventor, but only looks to whether some motivation or suggestion to combine references is provided by prior art taken as whole. “ *In re Beattie*, 24 USPQ2d 1040 (CA FC 1992).

**Claims 6 and 29 (dependent on claims 5 and 28):**

The rejection for these claims is set forth above. Applicants essentially argue they are unobvious because claims 5 and 28 are unobvious and offer no further challenges. The Examiner maintains claims 6 and 29 are obvious as rejected above.

Art Unit: 3622

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

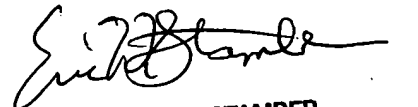
For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



**Khanh H. Le**

July 10, 2006



**ERIC W. STAMBER**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 3600**

**Conferees:**

Eric Stamber:



Robert Weinhardt: